

Appl. No. 09 836 158

Amtd. dated March 2, 2004

Reply to Office action mailed May 22, 2003

## **REMARKS/ARGUMENTS**

In order to reduce the issues on appeal, this Amendment would replace claim 15 with claim 29 and cancel claim 21. Claim 29 is dependent upon previous claim 23. Claim 16 would be amended to further clarify the claimed subject matter. Claim 21 is canceled for the purpose of expediting prosecution without prejudice to continuing prosecution of the claimed subject matter in a continuing application. No new matter would be added by entry of this amendment.

Applicant requests entry of the amendment to reduce the issues on appeal.

## **Status of the Claims**

Claims 2 and 15 to 28 are pending and under consideration. Upon entry of this amendment, claims 2, 16 to 20, and 22 to 29 would be pending for appeal.

## **Statement of the Rejections**

Claim 15 to 21, 27 and 28 stand rejected under 35 U.S.C. §112, second paragraph as indefinite for the reasons set forth in the Final rejection.

Claims 2 and 15 to 28 stand rejected under 35 U.S.C. §103 as unpatentable over Cornwell. The reference discloses a fuel element in the form of a log having an external layer of aluminum particles wherein the preferred form of the log has a central bore, the walls of which are also coated with aluminum particles. The Examiner has taken the position that although Cornwell “does not specifically teach that the aluminum is a product for disintegrating a combustion deposit layer”, the reference “suggests that no combustion deposits would form”. The Examiner has also taken the position that Cornwell “teaches that the log contains a bore and whether it is formed during compression or after compression is not critical”.

Claim 21 stands rejected under 35 U.S.C. §103 as unpatentable over Farjon. Upon entry of this amendment, claim 21 will be canceled.

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### **Applicants' Traversal**

Applicants traverse the rejections and respectfully request reconsideration in view of the following discussion.

#### **Claim 16 is in conformity with 35 U.S.C. §112 because the product of the method is an element having the disintegrating product in an internal space of the element**

Claim 16 is directed to a method of manufacturing a solid combustible element that comprises a product for disintegrating of a combustion deposit layer. The method comprises the steps forming an internal space in a solid combustible element and placing the product in the space. The Examiner has not given any reason why the method claim must set forth the method by which the solid element is made. Applicant submits that the solid combustible element is a starting material. The end product is the solid combustible element having the disintegrating product in an internal space of the element. Applicant submits that the claim is definite without recitation of how the solid combustible element itself is made.

**The Examiner has not established a *prima facie* case of obviousness of claims 2 and 15 to 28 over Cornwell.**

#### **Requirements For Prima Facie Case of Obviousness**

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

*Hodosh v. Block Drug Co., Inc.*, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

MPEP §2143 states the basic requirements of a *prima facie* case of obviousness citing supporting case law:

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1. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one skilled in the art to modify the references or combine reference teachings. (see MPEP §2143.01)
2. There must be a reasonable expectation of success. (see MPEP §2143.02)
3. The prior art reference (or references when combined) must teach or suggest all of the claim limitations. (see MPEP §2143.03)

The fact that references can be modified or combined is *not* sufficient to establish *prima facie* obviousness. (MPEP §2143.01).

The fact that the claimed invention may be within the capabilities of one of ordinary skill in the art is *not* sufficient by itself to establish *prima facie* obviousness. “A statement that modifications of the prior art to meet the claimed invention would have been ‘well within the skill of the art’ . . . is *not* sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references” (MPEP §2143.01 citing supporting case law).

### **Construction of the Claims**

As noted by the Federal Circuit “a determination of anticipation, as well as obviousness, involves two steps. First is construing the claim, . . . followed by, in the case of anticipation or obviousness, a comparison of the construed claim to the prior art. *Key Pharmaceuticals Inc. v. Hercon Laboratories Corp.*, 161 F.3d 709, 48 USPQ2d 1911 (Fed. Cir. 1998).

### **Differences Between the Prior Art and the Claimed Invention**

The factual inquiries for establishing a background for determining obviousness under 35 U.S.C. 103(a) are set forth in set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) and include determining the scope and contents of the prior art and ascertaining the differences between the prior art and the claims.

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**There is no motivation or suggestion in Cornwell to use a product for disintegrating of a combustion deposit layer in the central bore.**

Cornwell discloses that “the interior wall of the bore is sprayed with aluminum particles” (col. 2, lines 28-30). The Examiner acknowledges that the reference “does not specifically teach that the aluminum is a product for disintegrating a combustion layer”. There is no discussion in the reference about disintegrating a combustion layer nor is there any disclosure or suggestion of any products that would perform such a function.

The Examiner has not presented any argument that aluminum is capable of disintegrating any combustion layer. The Examiner has not presented any argument why one skilled in the art would be motivated to use a product for disintegrating a combustion layer instead of aluminum. Instead, the Examiner states that “the aluminum reacts with steam” and “that no combustion products would form”. These arguments fail to address the issue of a product having the ability to disintegrate a combustion layer. Therefore, Applicant submits that the Examiner has not established a *prima facie* case of obviousness of the claims over Cornwell.

**The Examiner has not provided any reasons why there would be a reasonable expectation of success from the disclosure of Cornwell.**

Since Cornwell does not discuss the disintegration of a combustion layer or any products capable of disintegrating a combustion layer, Applicant submits that the Examiner has not provided any reasons why there would be a reasonable expectation of success in disintegrating a combustion layer with aluminum in the central bore of the element of Cornwell. Therefore, the Examiner has not met this requirement for a *prima facie* case of obviousness.

**The Examiner has not established a *prima facie* case of obviousness of the dependent claims over Cornwell since the claims all require a product for disintegrating a combustion layer.**

The dependent claims all require a product for disintegrating a combustion layer. For the reasons discussed previously, the Examiner has not established a *prima facie* case of obviousness of the dependent claims over Cornwell.

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Applicants submit that a review of the prior art of record as a whole shows that the claims in the present application meet the requirements for patentability. It is respectfully requested that the Examiner reconsider her rejections of the claims and allow claims 2, 16 to 20, and 22 to 29.

Respectfully submitted,

LEFEVRE

BY

Maria Parrish Tungol  
Maria Parrish Tungol  
Registration No. 31,720  
Telephone: (202) 429-5249